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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,112	11/17/2003	Kaoru Murase	2003_1666	9790
513	7590	09/15/2005	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P.			CHEVALIER, ROBERT	
2033 K STREET N. W.				
SUITE 800			ART UNIT	
WASHINGTON, DC 20006-1021			PAPER NUMBER	
			2616	

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,112

Applicant(s)

MURASE ET AL.

Examiner

Bob Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art Figure 42c described at page 11, line 18, to page 12, line 2, of the present Application in view of the submitted prior art of Mori et al "EP 0896335 A2" and Official Notice.

The admitted prior art described at page 11, line 18, to page 12, line 2, Figure 42c of the present Application, shows a disc recording medium that shows substantially the same limitations recited in claims 1-2, including the feature of the area for recording video/audio data and wherein the audio data would include at least two of the following

a) dual monaural audio data having first audio channel data and second audio channel

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data, one of which is to be selectively reproduced, b) stereo audio data having first audio channel data and second audio channel data, which are simultaneously reproduced and c) monaural audio data having data for only one audio channel as specified in the present claims 1-2. (See the admitted prior art Figure 42c, described at page 11, line 22, to page 12, line 2, of the present Application).

The admitted prior art Figure 42c, described at page 11, line 22, to page 12, line 2, of the present Application, fails to specifically disclose the feature of the playback apparatus for reproducing the optical disk and the flag included in a management information area identifying the audio data included in the audio stream as specified in the present claims 1-2.

Mori et al discloses the playback feature recited in the present claims 1-2 including the feature of reading the flag and identifying the audio stream according to the flag as specified in the present claims 1-2. (See Mori et al's Figures 9, and 12, and the corresponding disclosure).

It would have been obvious to one skilled in the art to modify the admitted prior art Figure 42c, described at page 11, line 18, to page 12, line 2, of the present Application, wherein the disk medium provided thereof would incorporate the capability of a management information area having a flag signal recorded thereof so as to identify the audio data included in the audio stream and the capability of a playback means for the purpose of reproducing the recorded information and the flag signal recoded on the medium in the same conventional manner as is shown by Mori et al. The motivation

being to increase the accessing speed of data recorded on the recording medium during reproduction operation as suggested by Mori et al.

The proposed combination indicated above fails to specifically disclose the feature of generating the program list including audio information as specified in the present claims 1-2.

Examiner takes Official Notice in that it is notoriously well known in the video/audio recording art to have a recording medium having recorded thereon a program list of the video/audio information recorded on said recording medium as specified in the present claims 1-2.

It would have been obvious to one skilled in the art to modify the proposed combination indicated above wherein the recording means provided thereof would incorporate the capability of having recorded on the recording medium a program list in the same conventional manner as is notoriously well known in the prior art. Examiner has taken Official. The motivation is to allow the user to easily identify the programs recorded on the recording medium at reproduction as suggested in the prior art.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-2 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 5 of both U.S. Patent No. 6,377,747, and 6,611,655 in view of Official Notice.

Both U.S. Patent No. 6,377.747, and 6,611,655 disclose playback apparatus including the feature of the area for recording video/audio data and wherein the audio data would include at least two of the following a) dual monaural audio data having first audio channel data and second audio channel data, one of which is to be selectively reproduced, b) stereo audio data having first audio channel data and second audio channel data, which are simultaneously reproduced and c) monaural audio data having data for only one audio channel, and the feature of the flag which indicates whether a single audio stream includes at least two of said audio data as specified in the present claims 1-2. (See claims 4-5, of both U.S. Patent No. 6,377.747, and 6,611,655).

Both U.S. Patent No. 6,377.747, and 6,611,655 fails to specifically disclose the feature of generating the program list including audio information as specified in the present claims 1-2.

Examiner takes Official Notice in that it is notoriously well known in the video/audio recording art to have a recording medium having recorded thereon a program list of the video/audio information recorded on said recording medium as specified in the present claims 1-2.

It would have been obvious to one skilled in the art to modify the playback apparatus of the patented claims 4-5 of both U.S. Patent No. 6,377,747, and 6,611,655 wherein the recording medium provided thereof would incorporate the capability of having recorded on the recording medium a program list in the same conventional manner as is notoriously well known in the prior art. Examiner has taken Official. The motivation is to allow the user to easily identify the programs recorded on the recording medium at reproduction as suggested in the prior art.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Both Suzuki et al and Kikuchi et al disclose a video/audio reproducing apparatus having channels of audio signals recorded on the recording medium.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 571-272-7374. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Chevalier
August 19, 2005.


ROBERT CHEVALIER
PRIMARY EXAMINER